

REMARKS

Claims 1-2, 6-9, and 18-20 are now pending in the application. Claims 1, 6, 9 and 18 are amended herein. Claims 3-5 are cancelled herein. Claims 19-20 are added herein. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claim 18 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicants regard as the invention. Claim 18 is amended herein. It is believed that this amendment has rendered this rejection moot. Applicants therefore respectfully request reconsideration and withdrawal of the rejection.

REJECTION UNDER 35 U.S.C. § 102

Claims 1, 2, 7 and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Maffey, Jr. et al. (U.S. Pat. No. 3,369,615). Claim 1 is amended herein to include the subject matter formerly of claims 3-5. For at least the reasons stated below, it is submitted that claim 1 should be patentable. Claims 2, 7, and 18 depend from claim 1 and, for at least the same reasons, should also be patentable. Accordingly, withdrawal of the rejection is respectfully requested.

Additionally, claim 18 and new claims 19-20 call for the field case to be "closed relative to said first handle portion." Maffey, Jr. et al., however, does not disclose a field

case closed relative to a first handle portion. Therefore, for at least these reasons, claims 18-20 should be patentable.

REJECTION UNDER 35 U.S.C. § 103

Claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maffey, Jr. et al. in view of Taga (U.S. Pat. No. 6,719,067) or Milbourne (U.S. Pat. No. 6,502,648). Claims 4-6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maffey, Jr. et al. in view of Gass et al. (U.S. Pat. No. 6,536,536). These rejections are respectfully traversed.

As stated above, claim 1 includes the subject matter formerly of claims 3-5. Claim 1 and new claim 20 each call for “a field case and first handle portion formed as a single piece . . . wherein said field case includes a first slide rail for engaging a corresponding second slide rail on said second handle portion.” Claims 1 and 20 further state that “said end cap is disposed against said second handle portion for maintaining said second slide rail of said second handle portion in engagement with said first slide rail of said field case.”

Maffey, Jr. et al. and Gass et al., however, fail to disclose all of the subject matter of claims 1 and 20. The Examiner acknowledges that Maffey, Jr. et al. fails to disclose slide rails. See page 4 of the Office Action. As Gass et al. fails to disclose an end cap, neither Maffey, Jr. et al. nor Gass et al. discloses an end cap which maintains engagement of slide rails. Furthermore, Gass et al. fails to disclose a field case and a handle portion formed as a single piece with the field case including slide rails. In contrast, Gass et al. discloses a tool 10 including a fastening mechanism 70 (which

corresponds to the slide rails) when the handle of tool 10 is selectively removable (and, thus, a separate component). See at least column 4, lines 28-32 of the Gass et al. reference.

In the Office Action, the Examiner states that "[i]n view of the teachings of Gass et al., it would have been obvious to one skilled in the art to connect the handle of [Maffey] Jr., et al. to the field case via a slide rail configuration in order to more securely couple the elements together." See page 4 of the Office Action. For the reasons set forth below, Applicant respectfully requests reconsideration by the Examiner.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Additionally, in section 2143.01 of the MPEP it is stated:

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Applicants submit that there is no motivation or suggestion for the proposed combination of Maffey, Jr. et al. and Gass et al. As stated above, fastening mechanism

70 (which corresponds to the slide rails) of Gass et al. is included when the handle of tool 10 is selectively removable. See at least column 4, lines 28-32 of the Gass et al. reference. Therefore, Applicants submit that there is no motivation or suggestion to combine fastening mechanism 70 of Gass et al. with Maffey, Jr. et al. to couple the elements of Maffey, Jr. et al. together as called for in claims 1 and 20 of the present application. Accordingly, for at least these reasons, it is submitted that claim 1 defines patentable subject matter over the art, and withdrawal of the rejection is respectfully requested. Additionally, for at least these reasons, new claim 20 should also be patentable.

Claims 6 and 8-9 depend from claim 1 and, therefore, for at least the reasons stated above with respect to claim 1, should also be patentable. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 9 and new claims 19 and 20 each call for the opening in the first handle portion to define "a first recess for receiving electrical wires therein" and the field case to include "a first slide rail including a pair of spaced parallel rails defining a second recess therebetween for receiving the electrical wires." Claims 9 and 19-20 further call for the second handle portion to be "covering said first and second recesses."

The references fail to disclose or otherwise suggest all of this subject matter. As stated above, Gass et al. is relied upon for disclosing slide rails. See page 4 of the Office Action. However, Gass et al. fails to disclose slide rails defining a recess therebetween for receiving electrical wires. In contrast, Gass et al. discloses an upper portion 76 of a handle 16 engaging with a body 12. See at least Figures 2-3 and

column 4, lines 28-54 of the Gass et al. reference. Accordingly, for these additional reasons, it is submitted that claims 9 and 19-20 should be patentable.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 1-13-06

By: Ryan W. Massey
Ryan W. Massey, Reg. No. 38,543

HARNES, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

RWM/DWH/pvd